second format and an output graphics image to produce a scaled graphics stream, the video image scaling being independent of the graphics image scaling ; and

a merging block operatively coupled to the video scaler and the graphics scaler, wherein the merging block combines the scaled video stream and the scaled graphics stream to produce an video graphics output stream.

I. PROVISIONAL ELECTION OF CLAIMS

In the Restriction Requirement dated August 19, 2002, the Examiner has restricted the claims of the above-identified application under 35 U.S.C. §121 as follows:

Group I: Claims 2-19 and 31-37, drawn to merging independently scaled video and graphics, classified in class 345, sub-class 660; and

Group II: Claims 20-30, drawn to allocating memory in a video graphics system, classified in class 345, sub-class 543.

The Applicants provisionally elect, with traverse, the claims of Group I, claims 2-19 and 31-37 for continued prosecution. The Applicants reserve the right to file a Divisional Application for the non-elected claims of Group II at a later date.

II. THE RESTRICTION REQUIREMENT IS IMPROPER UNDER MPEP §811 AS BEING UNTIMELY AND SHOULD BE WITHDRAWN

The Applicants traverse the restriction requirement for the reasons set forth below. 37 C.F.R. §1.142(a) and MPEP §811 defines the time period for properly making a restriction requirement as being "...before any action upon the merits..." However, a restriction requirement may be made at any time before final action in a case. As stated in MPEP §811, "...the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible..." Under MPEP §811, the instant restriction requirement is untimely as being made well after the first action on the merits in this case; and, in fact, even after a final office action has been issued. Consequently, the instant restriction requirement should be withdrawn.

The above-identified application was filed on December 17, 1998, including claims 2-37, which are now subject to restriction. The Examiner performed a search on the entire application,

and issued a first action on the merits on March 28, 2001. In the first action, no restriction requirement was made. The Applicants filed a response to the first action on June 22, 2001.

In response to the Applicants June 22, 2001 response, the examiner issued a final office action on September 11, 2001. In the final office action, the examiner did not request restriction of the pending claims. Under MPEP §811, the last appropriate time to require restriction of the pending claims was September 11, 2001, the mailing date of the final office action. The Applicants filed a response to the final office action on November 16, 2001.

In response to the Applicants November 16, 2001 response, the examiner issued an Advisory Action on November 30, 2001, maintaining the final rejection of the pending claims. Again, no restriction requirement was made.

On December 18, 2001, the examiner and Applicants attorney, Christopher J. Reckamp, had a telephone interview regarding the above-identified application. Based on the Interview Summary Record provided by the examiner, the examiner did not orally request restriction of the then pending claims. In response to the Advisory Action and the telephone interview with the examiner, the Applicants filed a Request for Continued Examination (RCE) of the above-identified application on January 9, 2002.

In response to the January 9, 2002 RCE filing, the examiner issued a first action on the merits rejecting the pending claims. Again, no restriction requirement was made. The Applicants filed a response to the first action on the RCE on May 13, 2002.

On August 19, 2002, more than eleven months after issuing a final action on the above-identified application and more than three and one-half years after the filing date of the above-identified application, the examiner for the first time has issued a restriction requirement on the claims of the above-identified application. Under MPEP §811, the Applicants submit that the time for properly making a restriction requirement expired no later than the issuing of the final action on September 11, 2001. Consequently, as the time for properly making a restriction requirement has lapsed, the Applicants submit that the instant restriction requirement is improper and should be withdrawn. Accordingly, reconsideration of the restriction requirement is respectfully requested.

III. THE RESTRICTION REQUIREMENT IS IMPROPER UNDER MPEP §803 AND SHOULD BE WITHDRAWN AS THE EXAMINER IN THIS CASE WILL NOT BE SERIOUSLY OR UNDULY BURDENED BY CONTINUING TO EXAMINE THE ENTIRE APPLICATION

At the outset, the Applicants would like to direct the examiner's attention to an apparent typographical error in the pending restriction requirement, regarding the claims that are subject to restriction. On page 1 of the office action summary (e.g. restriction requirement), the examiner has indicated that claims 4-37 are currently pending in the above-identified application and are subject to restriction. No mention of pending claims 2-3 was made. However, on page 2, paragraph 1 of the office action, the examiner indicated that the claims of Group I include claims 2-19 and 31-37. Therefore, as the grouping of the claims on page 2 of the office action includes all the pending claims, 2-37, the Applicants are moving forward with the understanding that claims 2-3 were inadvertently left out of the office action summary due to a typographical error on page 1 thereof. If the examiner had another reason for not including claims 2-3 in the office action summary, the examiner is invited by the Applicants to address such reasons in a subsequent non-final communication.

In addition to the improper timing of the present restriction requirement as discussed above in Section II, the Applicants submit that the instant restriction requirement is improper under MPEP §803 as the Examiner will not be seriously or unduly burdened by continuing to examine the claims of the above-identified application, without restriction, as one search and at least one update search has already been performed by the examiner since the filing date of the above-identified application. As stated in MPEP §803, "...there must be a serious burden on the examiner if restriction is required..." In the instant case, no such burden is present.

The above-identified application, including the claims subject to the instant restriction requirement, has been pending before the same examiner since its filing on December 17, 1998. During the prosecution of the above-identified application, the examiner has performed at least one prior art search and one update search based on the several submissions filed by the Applicants in response to the examiner's non-final and final actions on the merits. At no point during the prosecution has the examiner requested restriction or indicated that she will be, or has been, unduly burdened by continuing to examine all the pending claims of the application. As the same examiner has been prosecuting the above-identified application from the initial filing date, has performed all the searching regarding the application and has provided no prior

indication either orally or in writing that restriction is necessary to adequately perform a single search of the pending claims of the above-identified application, the Applicants submit that the examiner will not be unduly burdened by continuing to examine the above-identified application. Accordingly, reconsideration of the restriction requirement is respectfully requested.

IV. THE RESTRICTION REQUIREMENT IS IMPROPER UNDER MPEP §§ 802 AND 803 AS THE CLAIMED SUBJECT MATTER IS NOT INDEPENDENT AND THE ADDITION OF NEW CLAIM 38 RENDERS THE RESTRICTION REQUIREMENT MOOT

The Applicants further traverse the instant restriction requirement as independence of claimed subject matter under MPEP §§802-803 has not been established. Under MPEP §§802-803, restriction is proper if two or more independent and distinct inventions are claimed in a single application. Independent means that there is no disclosed relationship between the two or more subjects disclosed, such as being unconnected in design, operation or effect. MPEP §802.01. In the instant case, the claims of groups I and II are disclosed as being connected. For example, claim 2 includes a limitation directed to:

> "...the graphics display engine allocates a size of the first memory block of the single memory and a size of the second memory block of the single memory based on needs of the video data and the graphics data..."

while claim 20 includes limitations directed to:

> "...allocating a first block of memory for storing the video data stream, the allocating based upon needs of the video data stream..." and
> "...allocating a second block of memory for storing the graphics data stream, the allocating based upon memory needs of the graphics data stream..."

Thus, at least one claim within each of the aforementioned claim groups currently subject to restriction defines common subject matter that is connected to the design, operation or effect of the invention disclosed in the above-identified application as required under MPEP §§802-803. Therefore, as the claims define subject matter that is not independent, the examiner will not be unduly burdened by continuing to examine the above-identified application. Consequently, the instant restriction requirement is improper and should be withdrawn.

Further, the Applicants have added new claim 38 to the above-identified application for consideration. Claim 38 is directed to a video graphics display circuit including, among other things, the following combination of elements:

> "...a memory maintaining video data having a first format and graphics data having a second format, wherein the memory allocated to the video data and the graphics data is based upon memory needs of the video data and the graphics data;
>
> a video scaler adapted to receive the video data, wherein the video scaler scales video images in the video data based on a ratio between the video images in the first format and an output video image to produce a scaled video stream;
>
> a graphics scaler adapted to receive the graphics data, wherein the graphics scaler scales graphics images in the graphics data based on a ration between the graphics images in the second format and an output graphics image to produce a scaled graphics stream, the video image scaling being independent of the graphics image scaling..."

As such, the claimed video graphics display circuit includes a memory which is allocated to video and graphics data based upon the needs of such data, in combination with video and graphics scalers which are operative to independently scale respective video and graphics data maintained in the memory. As such, claim 38 provides an integrated combination of the features recited, for example, in claims 4 and 20. As the allocated memory and the video and graphics scalers and corresponding functionality are defined as operating in cooperation with one another, the Applicants submit that the memory and video and graphics scaling elements and corresponding functionality of the instant invention are not independent and distinct within the meaning of MPEP §803 and, therefore, not subject to restriction as requested by the Examiner. Consequently, for the reasons set forth above, the Applicants respectfully request reconsideration of the restriction requirement in this case and examination of claim 38.

In view of the above remarks, reconsideration of the Restriction Requirement and the addition of claim 38 to the case are respectfully requested.

The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-0441 for any payment in connection with this communication, including any fees for extension of time, which may be required. The Examiner is invited to call the undersigned if such action might expedite the prosecution of this application.

Respectfully submitted,

By: _____
Loren H. McRoss
Registration No. 40,427

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VEDDER, PRICE, KAUFMAN &
KAMMHOLZ
222 N. LaSalle Street
Chicago, IL 60601
(312) 609-7500
FAX: (312) 609-5005